

REMARKS

Claims 1 and 4 have been amended to overcome the Examiner's objection in accordance with the Examiner's suggestions.

The Examiner has rejected claims 1-11 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Specifically, the Examiner has stated that claims 7 and 10 recite the limitation "silicone liners" and in claim 7 and there is insufficient antecedent basis for this limitation in the claim. In response thereto, the Applicant has amended claims 7 and 10 to delete the term "silicone" and correlate the terminology with the first part of claim 7 which uses the general term of "liner".

The Examiner has further stated that the term "imprintable" in claims 1 and 7 is a relative term which renders the claim indefinite stating that the term "imprintable" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

In addition, the Examiner has stated the term printable in claims 5 and 7 as a relative term. In response thereto, the Applicant has amended claims 5 and 10 to replace the term "printable" with "thermal imprintable".

The Applicant further traverses this rejection by the Examiner by reference to the original specification on page 5, line 17 through page 6 line 10.

It is therein stated, that thermal imprintable label stocks include a thermal sensitive coloring material comprising a colorless or light-colored leuco dye and an acidic substance capable of causing the leuco dye to undergo color formation upon heating of the thermo sensitive recording label. Further, the Applicant has set forth specific patents describing thermo sensitive paper stock on page 6, lines 4 through 6.

The Applicants submits that the indefiniteness requirement of 35 USC 112 is essentially a requirement for precision and definiteness of claimed language, so that the claims clearly define what subject matter they encompass and thus what the patent precludes others from doing. *In re Spiller*, 182 USPQ 614, 621 (CCPA 1974); see also *In re Johnson and Farnham*, 194 USPQ 187, 193 (CCPA 1997).

Relative to the precision requirement of 35 USC 112, the court in Georgia Pacific Corp. v. U.S. Plywood Corp., 118 USPQ 112, 132 (2nd Cir. 1958) stated that:

“This requirement serves two primary purposes: those skilled in the art must be able to understand and apply the teachings of the invention and enterprise and experimentation must not be discouraged by the creation of an area of uncertainty as to the scope of the invention.”

The test for indefiniteness under 35 USC 112 is whether one of ordinary skill in the art would understand that which is claimed when the claim is read in the light of the specification. Seattle Box Company v. Industrial Creating and Packaging, 221 USPQ 568, 574 (Fed. Cir. 1984); and Burlington Industries, Inc. v. Quigg, 229 USPQ 916, 920 (D.C. 1986).

The claims rejected by the Examiner include as elements thermal printable label stock. In view of the fact that the claims are interpreted in light of the specification and the specification not only defines the elements of the thermal and printable label but refers and incorporates by reference suitable thermal and printable label stock, the Examiner's rejection of the claims under 35 USC 112, second paragraph, cannot be supported.'

Moreover, the Applicant respectfully brings to the Examiner's attention the fact that claims 2 and 8 have been rejected by the Examiner on both an indefiniteness and an obviousness rejection, despite case law having made it clear that both rejections cannot exist at the same time. *Ex parte Head*, 214 USPQ 551, 553 (PTO Bd. Ap. 1981).

The logic of this decision is obvious; if a claim is so indefinite that one of ordinary skill in the art cannot determine what is being claimed, then how can the same invention be obvious? To allege both indefiniteness and obviousness at the same time, as the Examiner does here, is contrary to logic and also contrary to case law. It is, therefore, respectfully submitted that the facts do not support a finding of indefiniteness and the reversal of the Examiner's decision regarding claims 1-11 under 35 USC 112, second paragraph, is also respectfully requested.

Next, the Examiner has rejected claims 1, 3-7, and 9-11 under 35 USC 102(b) as being anticipated by U.S. 5,472,755 to Nibling, Jr.

In this rejection, the Examiner states that Nibling, Jr. discloses a runnable splice at column 1, line 6-10 comprising a first thermal imprintable label stock having a first face layer of thermal paper at column 6, lines 9-16.

The Applicant respectfully disagrees with the interpretation of the Examiner of Nibling, Jr. at column 6, lines 9-16, where it is stated:

“Referring now to FIGS. 1 and 2, the carrier sheets 30 may be any suitable material generally used for carrier sheets. Exemplary carrier sheets may be selected from kraft papers, super-calendared kraft papers, clay-coated kraft papers, polyolefin coated kraft papers, glassines, parchments and films. If the carrier sheet 30 is a film, the film may be one or more polyolefin films, polystyrene films and polyester films.”

The Applicant submits that there is no reference to thermal imprintable label stock. In fact, Nibling, Jr. does not utilize the term “thermal” throughout the entire disclosure, but rather is directed to pressure sensitive label stock.

The Applicant submits that anticipation is established only when a single prior art reference discloses, expressly, or under principles of inherency, each and every element of the claimed invention. RCA Corp. v. Applied Digital Data Systems, Inc., 221 USPQ 385 (Fed. Cir. 1984); *In re Sun*, 31 USPQ 2d 1451 (CAFC 1993); Advanced Display Systems, Inc. v. Kent State University, 540 USPQ 2d 1673 (CAFC 2000).

Further, the Examiner must identify wherein each and every facet of the claimed invention is disclosed in the applied reference. *Ex Parte Levy*, 17 USPQ 2d 1461 (USPTO Board of Patent Appeals and Interferences 1990).

In addition, the Applicants submit that anticipation must meet strict standards, and unless all of the same elements are found in exactly the same situation and united in the same way to form identical function in a single prior art reference, there is no anticipation. Tights, Inc. v. Acme-McCary Corporation, et al., 191 USPQ 305 (CAFC 1976).

Bearing in mind this criteria and the distinction hereinabove set forth, it is clear that the Nibling, et al. reference is directed to pressure sensitive label stock and not thermal imprintable label stock as presently claimed. Accordingly, in view of the lack of teaching of the thermal imprintable label stocks claimed in the present invention, a rejection under 35 USC 102 is not sustainable. Therefore, the Applicant respectfully requests the Examiner to withdraw the rejection of claims 1, 3-7, and 9-11 under 35 USC 102(b) on the basis of the Nibling, Jr. reference.

Claims 2 and 8 have been rejected by the Examiner under 35 USC 103(a) as being unpatentable over Nibling, Jr. in view of U.S. 5,530,517 to Patton, et al.

In this rejection, the Examiner states that Nibling, Jr. fails to disclose the third label having a width of between 0.5 inches and about 3 inches and accordingly relies on Patton, et al. to teach a label for splicing together and concludes it would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to provide the label with

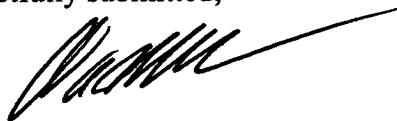
the desired width and spacing in order to splice two rolls of material together while presenting information about the rolls of materials as taught by Patton, et al.

The Applicant submits that Patton, et al. is also totally silent with regard to thermal imprintable label stock and accordingly provides no teaching whatsoever with regard to a runnable splice as presently claimed.

Therefore, the Applicant submits that the Examiner has not made a prima facie case of obviousness of claims 2 and 8 on the basis of the Nibling, Jr. and Patton, et al. references and respectfully requests the Examiner to withdraw the rejection.

In view of the arguments hereinabove set forth and amendment to the claims, it is submitted that each of the claims now in the application define patentable subject matter not anticipated by the art of record and not obvious to one skilled in this field who is aware of the references of record. Reconsideration and allowance are respectfully requested.

Respectfully submitted,



Walter A. Hackler

Attorney of Record

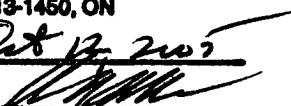
Registration No. 27,792

2372 S.E. Bristol, Suite B

Newport Beach, California 92660-0755

(949) 851-5010

HEREBY CERTIFY THAT THIS CORRESPONDENCE IS
BEING DEPOSITED WITH THE U.S. POSTAL SERVICE
AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED
TO: COMMISSIONER OF PATENTS, PO BOX 1450
ALEXANDRIA, VIRGINIA 22313-1450, ON

Oct 17, 2005
10/12/05
(DATE SIGNED) 
WALTER A. HACKLER
REG. NO. 27, 792